

TTAB

Docket No. 29WV-174976

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

<p>In re Matter of Application No. 85/409,938 for the mark: WELL.I.AM in Classes 9, 35, 38, 42 and 44</p> <p>William Adams and i.am.symbolic, llc,</p> <p>Opposers,</p> <p>vs.</p> <p>Nant Holdings IP, LLC,</p> <p>Applicant.</p>	<p>Opposition No. _____</p> <p>NOTICE OF OPPOSITION</p>
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TO: Commissioner for Trademarks
ATTN: Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

Opposer, William Adams, an individual, and his company i.am.symbolic, llc (hereinafter collectively "Opposer"), believe that they will be harmed by the registration of the mark WELL.I.AM, as shown in U.S. Application Serial No. 85/409,938 in Classes 9, 35, 38, 42 and 44 (hereinafter, the "Application"), and hereby opposes its registration on the following grounds:

BACKGROUND REGARDING OPPOSER AND THEIR MARKS

1. Opposer William Adams, known as will.i.am, the famous hip hop musician and founding member and frontman of the musical group The Black Eyed Peas, uses the I AM mark with his clothing line and with his licensed clothing lines offered under I AM and WILL.I.AM. Opposer uses the marks I AM and WILL.I.AM for clothing and has used such marks since before the filing date of the Application. Opposer also uses WILL.I.AM for entertainment, philanthropic, and entrepreneurial services, and entertainment-related goods, consumer



09-12-2013

U.S. Patent & TM Office: TM Main Rpt. Dt. #22

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electronic products, and other consumer products, the majority of which activities pre-date the filing date of the Application.

2. Opposer i.am.symbolic, llc is the owner of the incontestable registered trademark I AM, U.S. Registration No. 2,433,688, for “clothing, namely, hats, caps, socks, shirts, t-shirts, sweatshirts, tank tops, shorts, pants, sweatpants, jeans, and footwear, namely, shoes, and boots” in Class 25, and all other rights associated with clothing, headwear, footwear and other goods offered under the I AM mark. Attached hereto as **Exhibit A** is a true and correct copy of the registration for Opposer’s I AM mark in Class 25.

3. The I AM mark in Class 25 was registered by Groundlevel Footwear, Inc., an Arizona corporation (hereinafter, “Groundlevel”). Groundlevel filed its application leading to the registration of the I AM mark (U.S. Registration No. 2,433,688) on May 3, 2000, claiming a date of first use in commerce of January 15, 2000 and a date of first use anywhere of March 1, 1999. Groundlevel’s date of first use in commerce and date of first use anywhere precede the filing date of the Application. Opposer William Adams succeeded to all right and title to the I AM mark in Class 25 from Groundlevel. On July 19, 2013, Opposer William Adams assigned all right and title to U.S. Registration No. 2,433,688 to Opposer i.am.symbolic, llc.

4. Opposer owns a family of I AM marks, and promotes the family of marks together. Opposer owns the following I AM formative and WILL.I.AM trademark applications and/or registrations:

Mark	Classes	App./Reg. No.	Filing/ Reg. Date
WILL.I.AM	9	77/665,543	2/9/09
		3,678,106	9/1/09
WILL.I.AM	41	77/666,402	2/9/09
		3,707,981	11/10/09
WILL.I.AM	3, 14, 18 & 25	77/685,865	3/6/09
WILL.I.AM	9	85/916807	4/28/13
WILL.I.AM	41	85/916808	4/28/13

Mark	Classes	App./Reg. No.	Filing/ Reg. Date
WILL.I.AM	42	85/916809	4/28/13
I AM	25	76/039,669	5/3/00
		2,433,688	3/6/01
I AM	3	85/044,494	5/21/10
I AM	9	85/044,495	5/21/10
I AM	14	85/044,496	5/21/10
I AM	18	85/044,497	5/21/10
I AM	25	85/044,498	5/21/10
I AM	41	85/044,499	5/21/10
I AM ANGEL	41	85/538,986	2/10/12
I AM STEAM	41	85/733,334	9/19/12
I AM PLUS	9	85/788,915	11/28/12
I AM PLUS	14	85/788,916	11/28/12
I AM PLUS	18	85/788,917	11/28/12
I AM PLUS	25	85/788,918	11/28/12
I AM PLUS	41	85/788,919	11/28/12
I AM+	9	85/788,922	11/28/12
I AM+	14	85/788,923	11/28/12
I AM+	18	85/788,924	11/28/12
I AM+	25	85/788,925	11/28/12
I AM+	41	85/788,926	11/28/12
iam⁺	9	85/788,930	11/28/12
iam⁺	14	85/788,931	11/28/12
iam⁺	18	85/788,932	11/28/12
iam⁺	25	85/788,933	11/28/12
iam⁺	41	85/788,934	11/28/12

Such marks are collectively referred to as “Opposer’s Marks”.

5. Opposer William Adams advocates health and wellness individually and through his i.am.angel foundation. Wellness was also a topic during Mr. Adams’ TRANSFM event held in February 2013. Further, Mr. Adams’ i.am.foundation is implementing an i.am.wellness program, and has used such name informally for a few years. Mr. Adams is also a partner with The Coca-Cola Company, which is a brand that promotes sustainability. Finally, Mr. Adams also actively promotes S.T.E.M. education.

RELEVANT FACTS REGARDING THE APPLICATION

6. On August 29, 2011, Applicant Nant Holdings IP, LLC, a Delaware limited liability company having an address of 10182 Culver Boulevard, Culver City, California 90232 (hereinafter “Applicant”), filed the Application in the United States Patent & Trademark Office seeking registration, on an intent to use basis, of WELL.I.AM for use with computer hardware and computer software programs for the integration of text, audio, graphics, still images and moving pictures into an interactive delivery for multimedia applications; software and hardware for the integration of health data from patients, providers and payers; computer hardware and software used to gather and search data in real time for use in medical research and for healthcare services; computer software and hardware for the integration of personal, entertainment, security and health information for sending, receiving, recording, searching, storing, processing, manipulating and transmitting of information, data, voice, text, images, sound and documents; computer software and hardware for the integration of personal, entertainment, security and health electronic apparatus and equipment; downloadable text files, written documents, audio material, image files and video material featuring information regarding healthcare and medical services. in Class 9, health care cost review, health care cost containment, consulting services in the cost and payment management of health care; electronic data collection and data submission services for business purposes in the field of next-generation diagnostics and pharmaceuticals used to target pre-selected patients based on molecular profiles to predict drug response to particular therapeutics; promoting collaboration within the scientific,

research and medical communities to achieve advances in the field of healthcare; providing medical referrals by using a database containing patient data, bioinformatics, discovery research, molecular medicine, and clinical developments designed to match patients with their personalized treatment regimens and preferred healthcare providers; data collection processing and data services in the fields of medicine and healthcare, the collection, reporting, and analysis of healthcare quality data for business purposes; data processing services in the fields of medicine and healthcare; providing technical consulting services and information management services, namely clinical data and regulatory submission management to medical, biopharmaceutical and biotechnology companies to assist them with clinical research, clinical trials and applications for drug approval; services comprising the recording, transcription, composition, compilation and systematization written communications and recordings in the field of health care; medical referrals for health care and medical treatment in Class 35, telecommunication services, namely, instant messaging services, voice over internet protocol (VOIP) services, electronic data transmission of data and documents via computer terminals and electronic devices; peer-to peer network computer services, namely electronic transmission of audio, video and other data and documents among computers, providing on-line electronic bulletin boards for transmission of messages among computer users concerning medical and healthcare services, fitness, music, education, entertainment and popular culture; streaming of audio, visual and audiovisual material via a global computer network; providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the field of medical, health care, health care products and services, fitness, music, education, entertainment and popular culture; email data services in the fields of medicine and healthcare in Class 38, entertainment and education services, namely, providing information, news and commentary in the fields of entertainment, music and popular culture; providing information and news about education; conducting seminars, classes and educational programs dealing with medical, health, wellness and fitness issues in Class 41, information technology and data services, namely, integration of computer systems and networks; computer services, namely creating searchable

databases of information and data and for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of health and medical data and generation of reports thereof; providing use of a non-downloadable web based software application to ensure selection of and reimbursement for appropriate treatments for illnesses and to reduce cost and unnecessary utilization in the treatment of critical illnesses and to provide medical information between providers, subscribers and insurers; creating an online community for registered users to participate in discussions, get feedback from others, engage in networking featuring social media and topics on health care and fitness; research and development of next generation pharmaceuticals; research and development of next generation diagnostics and therapeutics tailored to specific molecular profiling of patient tissues and treatments for critical illnesses; medical and pharmaceutical research and development in the field of next-generation diagnostics and pharmaceuticals to target pre-selected patients based on molecular profiles to predict drug response to particular therapeutics; data collection service using proprietary software to evaluate, analyze and collect service data in the fields of medicine and healthcare; computer services, namely creating an on-line community for registered users to participate in discussion and on-line messaging in the fields of medical, health care, healthcare products and services, fitness, music, education, entertainment and popular culture in Class 42, and medical and health care services; providing medical information regarding healthcare and medical services by means of a global computer network; provision of wellness and disease management programs, provision of health care and medical services by health care professionals via the internet or telecommunication networks; medical information services, namely, providing a website featuring audio, video, photographic and prose presentations regarding healthcare and medical services; interactive medical monitoring and alert services for reminding clients of medical information, namely, medicinal dosage, allergic sensitivity and prescription refills; managed health care services; consulting services in the field of health, namely consulting services among medical providers, insurers and patients with critical illnesses; providing medical evaluation services, namely functional assessment for patients receiving treatment for the purpose of

guiding treatment and assessing program effectiveness; providing medical information, consultancy and advisory services; providing information and news in the field of health; maintenance of medical records in Class 44.

7. On September 14, 2012, the Office issued a non-final office action refusing registration of the applied-for mark because of a likelihood of confusion with U.S. Registration No. 3,678,106 for the mark WILL.IAM in Class 9 owned by i.am.symbolic, llc, and U.S. Registration No. 3,707,981 for the mark WILL.IAM in Class 41 owned by i.am.symbolic, llc. Attached hereto as **Exhibit B** are true and correct copies of the registrations for Opposer's WILL.IAM marks in Classes 9 and 41.

8. On March 14, 2013, Applicant filed its office action response arguing against the likelihood of confusion with U.S. Registration No. 3,678,106 for the mark WILL.IAM in Class 9, and deleted Class 41 from its application.

9. The Application was published for opposition in the Official Gazette on May 7, 2013. Opposer William Adams and Opposer i.am.symbolic, llc obtained extensions of time to oppose the Application. Opposer William Adams is in privity with Opposer i.am.symbolic, llc because William Adams formed i.am.symbolic, llc and is a Manager of i.am.symbolic, llc.

FIRST GROUND FOR OPPOSITION

(Likelihood of Confusion)

10. Opposer incorporates the allegations contained in Paragraphs 1 to 9 herein.

11. Applicant's proposed mark is confusingly similar to Opposer's Marks, and Opposer has priority. Further, the goods and services to be offered by Applicant are similar and related to, those offered or to be offered under Opposer's Marks, and Opposer's Marks are strong and entitled to a wide scope of protection.

SECOND GROUND FOR OPPOSITION

(Dilution)

12. Opposer incorporates the allegations contained in Paragraphs 1 to 11 herein.

13. The I AM mark and the WILL.I.AM mark are famous and distinctive within the meaning of the Federal Trademark Dilution Act. Applicant filed the Application after the I AM mark and the WILL.I.AM mark became famous, and Applicant seeks to commercially use and/or continue to use the mark WELL.I.AM.

14. The registration of the mark shown in the Application is likely to dilute the I AM mark and the WILL.I.AM mark.

THIRD GROUND FOR OPPOSITION DAMAGE TO OPPOSER

(False Association)

15. The mark and name WILL.I.AM is associated with Opposer William Adams and/or Opposer i.am.symbolic, llc. The name and mark WILL.I.AM is recognized as such, in that it uniquely and unmistakably points to Opposer William Adams and/or Opposer i.am.symbolic, llc.

16. The mark shown in the Application is a close approximation of William Adams' professional name WILL.I.AM and creates a false association with Opposer William Adams and/or Opposer i.am.symbolic, llc.

17. Opposer's Marks were used, or the subject of pending applications, prior to Applicant's use of WELL.I.AM or filing date of the Application.

18. Neither Opposer is connected with the goods or services sold, to be sold, offered, or to be offered by Applicant under the WELL.I.AM mark. The fame and reputation of Opposer William Adams is of such a nature that a connection with Opposer is presumed when Applicant's WELL.I.AM mark is used on or with or to promote, Applicant's goods and services.

19. Applicant's proposed mark WELL.I.AM is likely to create a false association, connection or affiliation with Opposer or as to the origin, sponsorship or approval of Applicant's goods, services, or commercial activities by Opposer.

FOURTH GROUND FOR OPPOSITION

(No Bona Fide Use)

20. Opposer incorporates the allegations contained in Paragraphs 1 to 19 herein.

21. On information and belief, at the time the Application was filed, Applicant did not have a bona fide intent to use Applicant's mark on or with all of the goods and services identified with the Application.

DAMAGE TO OPPOSER

22. As a result of all of the foregoing, the maturation of the Application into a registration would cause a likelihood of confusion, mistake, or deception with Opposer and Opposer's Marks, a likelihood of association, connection or affiliation with Opposer or as to the origin, sponsorship or approval of Applicant's goods, services or commercial activities by Opposer, and a likelihood of dilution of, Opposer's I AM mark and the WILL.I.AM mark.

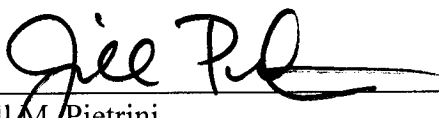
23. Opposer would be damaged by the registration of the mark shown in the Application, in that such registration would give Applicant a *prima facie* exclusive right to the use of WELL.I.AM, despite the likelihood of confusion, mistake, or deception with Opposer and Opposer's Marks, likelihood of association, connection or affiliation with Opposer or as to the origin, sponsorship or approval of Applicant's goods, services or commercial activities by Opposer, and likelihood of dilution described above, and will allow Applicant to trade on Opposer's existing goodwill in the I AM mark and the WILL.I.AM mark.

24. The Board is authorized to charge the requisite \$3,000 opposition filing fee (\$300 per class per Opposer) and any additional amounts to **Deposit Account No. 50-5691**.

WHEREFORE, Opposer prays that this Opposition be sustained in favor of Opposer, that the Application be rejected, and that registration of the Application be refused.

Respectfully submitted,

Dated: September 4, 2013



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(310) 228-3700

Attorneys for Opposers William Adams and i.am.symbolic, llc

CERTIFICATE OF SERVICE

I hereby certify that this Notice of Opposition is being deposited with the United States Postal Service, postage prepaid, first class mail, in an envelope addressed to:

Nant Holdings IP, LLC
10182 Culver Boulevard
Culver City, California 90232

Mei Tsang
Fish & Associates, PC
2603 Main Street, Suite 1000
Irvine, California 92614

on this 4th day of September, 2013.



LaTrina A. Martin

CERTIFICATE OF MAILING

I hereby certify that this Notice of Opposition is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, Attn: Trademark Trial And Appeals Board, P.O. Box 1451, Alexandria, VA 22313-1451, on this 4th day of September, 2013.



LaTrina A. Martin

SMRH:410023264.1

Exhibit A

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

United States Patent and Trademark Office

Reg. No. 2,433,688

Registered Mar. 6, 2001

**TRADEMARK
PRINCIPAL REGISTER**

I AM

GROUNDLEVEL FOOTWEAR, INC. (ARIZONA
CORPORATION)
30407 N. 48TH PLACE
CAVE CREEK, AZ 85331

FOR: CLOTHING, NAMELY, HATS, CAPS,
SOCKS, SHIRTS, T-SHIRTS, SWEATSHIRTS, TANK
TOPS, SHORTS, PANTS, SWEATPANTS, JEANS,
SWIMWEAR, SWIMSUITS, BEACHWEAR AND

FOOTWEAR, NAMELY, SHOES, ATHLETIC FOOT-
WEAR, BOOTS, CLOGS, SNEAKERS AND SAN-
DALS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 3-1-1999; IN COMMERCE 1-15-2000.

SER. NO. 76-039,669, FILED 5-3-2000.

MIDGE BUTLER, EXAMINING ATTORNEY

Exhibit B

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36, and 38

United States Patent and Trademark Office

Reg. No. 3,678,106

Registered Sep. 1, 2009

**TRADEMARK
SUPPLEMENTAL REGISTER**

WILL.I.AM

ADAMS, WILLIAM (UNITED STATES INDIVIDUAL)
C/O GOLDRING HERTZ & LICHTENSTEIN, LLP
450 N. ROXBURY DR., 8TH FL.
BEVERLY HILLS, CA 90210

FOR: SERIES OF PRE-RECORDED PHONOGRAPH RECORDS, CDS AND AUDIO CASSETTES FEATURING MUSIC; SERIES OF PRE-RECORDED VIDEO TAPES AND DVDS FEATURING MUSIC VIDEOS AND MUSICAL PERFORMANCES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 10-2-2001; IN COMMERCE 10-2-2001.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

THE NAME(S), PORTRAIT(S), AND/OR SIGNATURE(S) SHOWN IN THE MARK IDENTIFIES A LIVING INDIVIDUAL WHOSE CONSENT(S) TO REGISTER IS OF RECORD.

SER. NO. 77-665,543, FILED 2-6-2009.

LINDA ESTRADA, EXAMINING ATTORNEY

United States of America

United States Patent and Trademark Office

WILL.I.AM

Reg. No. 3,707,981 ADAMS, WILLIAM (UNITED STATES INDIVIDUAL)
Registered Nov. 10, 2009 C/O GOLDRING, HERIZ & LICHTENSTEIN, LLP
450 N. ROXBURY DR., 8TH FL.
BEVERLY HILLS, CA 90210

Int. Cl.: 41

FOR: ENTERTAINMENT SERVICES, NAMELY, LIVE MUSICAL PERFORMANCES BY A
MALE ARTIST; AND FASHION DESIGNER, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

**SERVICE MARK
PRINCIPAL REGISTER**

FIRST USE 6-30-1989; IN COMMERCE 6-30-1989.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

THE NAME(S), PORTRAIT(S), AND/OR SIGNATURE(S) SHOWN IN THE MARK IDENTIFIES A LIVING INDIVIDUAL WHOSE CONSENT(S) TO REGISTER IS OF RECORD.

SER. NO. 77-666,402, FILED S.R. 2-9-2009 AM. P.R. 7-20-2009.

LINDA ESTRADA, EXAMINING ATTORNEY



David J. Kypos

Director of the United States Patent and Trademark Office